

REMARKS

Reconsideration of the December 10, 2002 Official Action is respectfully requested. Claims 26-40 and 43-55, as amended, are pending in the application for the Examiner's review and consideration. Claims 56-64 have been canceled without prejudice or disclaimer of the subject matter thereof.

Independent Claims 26 and 39 have been amended to recite first and second layers of combustible material. Support for this change can be found on page 9, lines 3-10 of the specification. As no new matter has been introduced by these changes, they should be entered at this time.

Claim 63 was objected to for containing a typographical error. Claim 63 has been canceled. Accordingly, withdrawal of this objection is requested.

Claims 26-34, 37-40, 43-48, 50, 53-59 and 62¹ were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by European Publication No. 0 227 424 to Bale et al. ("Bale"). The reasons for the rejection are set forth in numbered paragraph 3 on pages 2-4 of the Official Action. This rejection is respectfully traversed.

In order to establish anticipation under §102(b), all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986), *cert. denied*, 107 S. Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1981), *cert. denied*, 469 U.S. 851 (1984), "anticipation requires that each and every

¹ Claims 56-59 and 62 have been canceled. Accordingly, the rejection of Claims 56-59 and 62 should be withdrawn.

element of the claimed invention be disclosed in a prior art reference." In the present case, Bale clearly fails to anticipate or render obvious the claimed subject matter.

Independent Claim 26 recites a cigarette wrapper for a cigarette having reduced sidestream smoke between puffs, comprising (i) a first layer of combustible material adapted to be formed around smoking material; and (ii) a second layer of combustible material formed around said first layer, wherein said second layer reduces combustion of said smoking material between puffs, wherein said first layer is more combustible than said second layer when exposed to thermal energy generated by said smoking material.

Independent Claim 39 recites a smoking article having reduced sidestream smoke between puffs, comprising (i) a smoking material; (ii) a first layer of combustible material formed around said smoking material; and (iii) a second layer of combustible material formed around said first layer, wherein said second layer reduces combustion of said smoking material between puffs, wherein said first layer is more combustible than said second layer when exposed to thermal energy generated by said smoking material.

Bale discloses a pipe, which is a holder or container for smoking material but is not itself wholly consumed during the smoking operation (See page 1, lines 6-9). A preformed plug of tobacco 30 is enclosed in a laminate 9 including an innermost layer 12 of permeable paper surrounded by *incombustible* layer 14 and an outer layer of *incombustible* foil 16 (See abstract and page 2, line 13-page 3, line 8).

Applicants submit that Bale does not disclose a first layer of combustible material and a second layer of combustible material formed about the first layer. As disclosed on

page 1, lines 18-27 of Bale, the pipe has an *incombustible* cylindrical component adapted to extend over the length of a preformed rod of smoking material.

Thus, it is submitted at least for the reasons discussed above that independent Claims 26 and 39, as well as the claims dependent thereon are clearly patentable over Bale.

With regard to the rejection of Claim 18 on page 3 of the Official Action, it should be noted that Claim 18 was canceled in the Preliminary Amendment.

Claims 35-36, 49, 51-52, 60-61 and 63² were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bale in view of U.S. Patent No. 5,551,451 to Riggs et al. ("Riggs") and U.S. Patent No. 5,360,023 to Blakley et al. ("Blakley"). The reasons for the rejection are set forth in numbered paragraph 6 on pages 5-7 of the Official Action. The Official Action alleges that it would have been obvious to combine the composite layers of Riggs with the smoking article of Bale. The Official Action further alleges that it would have been obvious to combine the size, number and relative positioning of perforations disclosed by Blakley with Riggs and Bale. This rejection is respectfully traversed.

Claims 35-36, 49, 51-52 depend from independent Claims 26 and 39 and thus are patentable over Bale, Riggs and Blakley for at least the same reasons that independent Claims 26 and 39 are patentable over Bale.

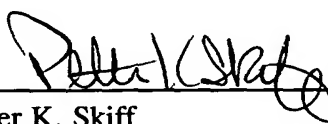
It is submitted that the differences between the claimed subject matter and the prior art are such that the claimed subject matter, as a whole, would not have been obvious at the time the invention was made to a person having ordinary skill in the art.

²Claims 60-61 and 63 have been canceled.

In view of the foregoing, it is submitted that the present application is in condition
for allowance and such action is earnestly solicited.

Respectfully submitted,

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**Attachment to Amendment
Appendix A - Marked up Version of the Claims**

26. (As Amended) A cigarette wrapper for a cigarette having reduced sidestream smoke between puffs, comprising:

a first layer of combustible material adapted to be formed around smoking material;
and

a second layer of combustible material formed around said first layer, wherein said second layer reduces combustion of said smoking material between puffs, wherein said first layer is more combustible than said second layer when exposed to thermal energy generated by said smoking material.

39. (As Amended) A smoking article having reduced sidestream smoke between puffs, comprising:

a smoking material;

a first layer of combustible material formed around said smoking material; and

a second layer of combustible material formed around said first layer, wherein said second layer reduces combustion of said smoking material between puffs, wherein said first layer is more combustible than said second layer when exposed to thermal energy generated by said smoking material.